

Serial No.: 10/788,569

Art Unit: 3744

Attorney Docket No.: 2001P14034WOUS

REMARKS

Reconsideration of the application is requested.

Applicants appreciatively acknowledges the Examiner's confirmation of receipt of Applicants' claim for priority under 35 U.S.C. § 119(a)-(d).

Reconsideration of the application is requested.

Claims 8 to 15 remain in the application.

Initially, Applicants note that headings have been added to the specification. No new matter has been added.

On page 2 of the above-identified Office Action, Claims 8 to 12 have been rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,934,088 to Takeda (hereinafter "Takeda") in view of U.S. Patent No. 4,381,549 to Stamp, Jr. et al. (hereinafter "Stamp").

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 8 calls for, *inter alia*, a refrigerating appliance, including:

a control unit checking operativeness of a coolant circuit if first checking the operativeness of the

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temperature sensor does not provide an indication of a malfunction of the temperature sensor.

Simply put, whether or not the coolant circuit is operative is checked only after a check of the temperature sensor indicates that the sensor is functioning. Thus, the priority of the temperature sensor is **always higher** than the priority of the coolant circuit.

Takeda discloses an error monitoring apparatus in a refrigerator. The Takeda error codes are described from col. 5, line 13, to col. 7, line 55. The error priority, however, is described only at col. 3, lines 58 to 61. The Takeda processor is able to detect "the occurrence of plural errors." Id. at col. 5, lines 14 to 15 and 18. All plural error codes are written into a priority order file "in the order of priority." Id. at col. 8, line 23; see also lines 15 to 22. Error codes are addressed, as set forth in col. 8, lines 24 to 40, only in the order of priority. Only after the highest priority error code is addressed is the next lower priority error code then addressed.

There exists the possibility that there is no error in the Takeda temperature sensor, but there is an error in any of defrost (E3), high pressure (E4), and/or clog sensor (E7 or E9). In such a case, the error resolution will not address

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the temperature sensor at all and will first address error code E9. The Takeda system will next address error code E4, will next address error code E7, and will lastly address error code E3. In such a case, the Takeda device will not be checking the operation of the coolant circuit *after* checking the temperature sensor as set forth in Claim 8. Instead, it will be checking resolution of the coolant circuit *before* the temperature sensor - a situation that is entirely in contrast to the features of Claim 8.

The Examiner combines Stamp with Takeda because:

Stamp teaches checking the operativeness of temperature sensors before checking for other possible system malfunctions (see col. 8, line 68 to col. 9, line 47). It would have been obvious to one of ordinary skill in the art . . . to have modified the system of Takeda such that it included checking the operativeness of temperature sensors before checking for other possible system malfunctions in view of the teachings of Stamp."

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be

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understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id.* (quoting *W.L. Gore & Assocs. Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, **there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant.** See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Therefore, to make such a drastic modification to Takeda -- as suggested by the Examiner-- there must be some motivation to do so.

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The motivation, suggestion, or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See *WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether an Examiner relies on an express or an implicit showing, **the Examiner must provide particular findings related thereto.** See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone **are not "evidence."** *Id.* When an Examiner relies on general knowledge to negate patentability, **that knowledge must be articulated and placed on the record.** See *In re Lee*, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

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The Examiner has provided no support or reason at all why Takeda would be modified using the features disclosed by Stamp other than "[i]t would have been obvious." Applicants respectfully believe that Takeda, itself, discloses otherwise and entirely prevents reaching such a conclusion.

Simply put, the Examiner believes that Stamp's teaching would motivate someone to change the order of priority of Takeda such that temperature sensor priority is **always greater than** the cooling circuit. However, Takeda only discloses one order for priority of error resolution and suggests none other. Takeda especially does not teach or suggest changing that single order of priority. That particular order is specifically set forth in col. 3, line 61. Takeda teaches only that order and never wavers. Thus, the Takeda disclosure teaches against changing its priority order. So, one having ordinary skill in the art would not try to use Stamp to change that order because, to do so, would eviscerate the singular teaching of Takeda.

Upon evaluation of the Office Action and the cited prior art, Applicants respectfully believe that the evidence adduced is insufficient to establish a *prima facie* case of obviousness with respect to the claims. Accordingly, the rejection of Claims 8 to 12 should be withdrawn.

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On pages 2 to 3 of the above-identified Office Action, Claims 13 to 15 have been rejected under 35 U.S.C. § 103(a) as being obvious over Takeda in view of Stamp and further in view of U.S. Patent No. 4,663,940 to Suzuki et al. (hereinafter "Suzuki").

Insofar as Claim 8 is believed to be allowable, and due to the fact that Claims 13 to 15 are ultimately dependent upon allowable Claim 8, these dependent claims are believed to be allowable based upon such dependency. Suzuki does not provide the teaching lacking in the basic combination of Takeda in view of Stamp. Thus, Applicants respectfully believe that the rejection of these claims should be withdrawn.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of Claim 8. Claim 8 is, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on Claim 8.

In view of the foregoing, reconsideration and allowance of Claims 8 to 15 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving

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a telephone call so that, if possible, patentable language can be agreed upon.

Please note, the enclosed Supplemental Application Data Sheet has been corrected to provide additional attorney contacts.

John T. Winburn

Name of Attorney Signing

Respectfully submitted

A handwritten signature in black ink, appearing to read 'J. Winburn', is written over the printed name.

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August 19, 2005

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